



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| | | | | |
|--|--------------|----------------------|---------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/752,345 | 01/06/2004 | Luc Mainville | 055189-0011 | 4226 |
| 20572 | 7590 | 09/19/2008 | EXAMINER | |
| GODFREY & KAHN S.C. 780 NORTH WATER STREET MILWAUKEE, WI 53202 | | | CHAPMAN, JEANETTE E | |
| ART UNIT | PAPER NUMBER | | | |
| 3633 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 09/19/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|--|---------------------------------------|
| Office Action Summary | Application No. 10/752,345 | Applicant(s) MAINVILLE, LUC |
| | Examiner Jeanette E. Chapman | Art Unit 3633 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 May 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recited added text of "and areas where the fluid is absent on a side of the first end" lacks a positive antecedent basis in the specification. The claims will be rejected as previously drafted

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1,2,4,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Notenboom (3653302).

Notenboom discloses a telescopic hoist, operated by a fluid, open to the atmosphere at a first end thereof and having an hydraulic inlet port 35 at a second end thereof opposite said first end, the hoist comprising:

Art Unit: 3633

a series of tubular sections, each tubular section 2-5 being closed by a piston head 8-12 on a side of said second first end with an opening 18/37 for passage of a fluid under pressure through successive areas enclosed between two successive piston heads; see figure 1 and

wherein each piston head comprises a bore seal, each bore seal 43/45/42/47 providing a sealing wall between said successive areas where the fluid is present, on a side of said second end and areas reached by air, on a side of said first end and

wherein said tubular sections are formed in a steel, surfaces of walls in the steel of the tubular sections being in contact with one another as the tubular sections are telescopically displaced as a result of introduction of the fluid under pressure, surface asperities of the surfaces providing formation of a film of the fluid on the sliding walls of the telescopically arranged and moving tubular sections. Notenboom does not disclose nitride steel as a material of construction but one of ordinary skill in the art would have appreciated using any form of steel commensurate with the function and purpose of the hoist

claim 2

Notenboom discloses a telescopic hoist, open to the atmosphere at a first end thereof opposite a second end thereof provided with a fluid inlet 35, comprising:

a series of telescopically actuatable tubular sections 2-5

Art Unit: 3633

each tubular section being closed by a piston head 8-12 having an opening 18/37, on a side of said second end, for passage of a pressure fluid therethrough; and bore seals means 42/43/45/47 between areas enclosed by two successive piston heads~ maintaining the fluid on said side of the second end; wherein said hoist is formed in a and, surfaces of walls in the steel of the tubular sections being in contact with one another as the tubular sections are telescopically displaced as a result of introduction of the fluid under pressure, surface asperities of the telescopically sliding surfaces -provide formation of a film of the fluid thereon, on the sliding walls of the telescopically arranged and moving tubular sections.

Notenboom does not disclose nitride steel as a material of construction but one of ordinary skill in the art would have appreciated using any form of steel commensurate with the function and purpose of the hoist.

claim 4

Notenboom discloses a telescopic hoist, operated by a fluid under pressure at a first end thereof and open to the atmosphere at a second end thereof, comprising: a cylindrical housing 5; a series of fluid pressure actuatable tubular sections 2-4 telescopically received in said housing; each said tubular section closed by a piston head 8-11 with an inlet port 35/18 for passage of a pressure fluid therethrough from a side of said first end said open side ; and bore seal means 42/43/45/47 mounted in said piston heads maintaining said fluid on said side of said first end of said piston heads;

Art Unit: 3633

wherein said tubular sections are formed in steel, a film of the fluid forming on asperities of walls of the tubular sections on said side of said first as they are telescopically displaced under action of the fluid under pressure.

Notenboom does not disclose nitride steel as a material of construction but one of ordinary skill in the art would have appreciated using any form of steel commensurate with the function and purpose of the hoist

Claim 5

Notenboom discloses a bore seal telescopic hoist, operated by a fluid under pressure, comprising:

a series of tubular sections 2-4; and

a tubular housing 5 with an open end to receive said series of tubular sections, said tubular sections being telescopically arranged in said tubular housing;

wherein said series of tubular sections comprises an outermost tubular section 5 and at least two inner tubular sections section 2-4, said outermost tubular section having a head 12 provided with a hydraulic inlet port 35 allowing a fluid to be introduced in a first area between said head and a piston head of an outermost one of said at least two inner tubular sections , said outermost one of said at least two inner one inner tubular sections having an opening 37 allowing the fluid to be received in a second area enclosed between the piston head thereof and a piston head of a successive tubular section, each piston head being provided with a bore seal 42-47 confining the fluid on a side of the hydraulic inlet port thereof facing the open end of the tubular housing,

said tubular sections being made in a steel, and, when the tubular sections are telescopically displaced under action of the fluid under pressure a film of the fluid is formed, on said side of the hydraulic inlet port on sliding walls of the telescopically arranged and moving tubular sections due to a presence of surface asperities thereon. Notenboom does not disclose nitride steel as a material of construction but one of ordinary skill in the art would have appreciated using any form of steel commensurate with the function and purpose of the hoist.

Applicant's arguments have been considered but are deemed moot in view of the new ground of rejection. Arguments are directed to the new matter text and are therefore moot since this area must first be addressed before proceeding with prosecution. The declaration of Mr. Mainville dated 5/21/08 is no longer applicable since the rejection involving the patent '538 has/ is no longer applied as a rejection against the claims .

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3633

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JEANETTE CHAPMAN/
PRIMARY EXAMINER
ART UNIT 3633

Application/Control Number: 10/752,345

Art Unit: 3633

Page 8